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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,413	01/04/2000	ZACHARY DAVID DIMENSTEIN	P55941	9205

7590 10/14/2003

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EXAMINER

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/477,413

Applicant(s)

DIMENSTEIN, ZACHARY DAVID

Examiner

Paula W Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said central server" in line 24. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim 1** is rejected under 35 U.S.C. 102(e) as being anticipated by Kupka et al (6,434,535 B1).

Kupka suggest a digital content encryption apparatus, comprising: a first server maintaining an approved website database comprising a list of the web sites determined to be authorized sources of files for digital storage devices manufactured to use a key to decrypt and play the files, said first server being connectable to an Internet (Fig. 1), and: when prompted by a user via a computer or an Internet enabled digital storage device, making a query to determine

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whether a submitted IP address supplied by the user is on said Approved Web Site Database (step 302 Fig. 7 in combination with column 15 lines 5-10). The query is done on the media, if the media comes from a legitimate source then the Web Site is implicitly determined to be an approved web site. When a determination is made that said submitted IP address is on the Approved Web Site Database, generating encryption key and encryption information that is unique to a selected file requested by the user to be downloaded and to any device to which it is being downloaded and transmits it to the Software Program and transmits unique encryption key/encoding, information to the Software Program when the Software Program requests one for the purpose of encoding digital content that is being copied from a media storage peripheral device onto the device's own digital storage memory (column 19 lines 14-20). A personal computer comprised of a memory storing a software program comprised of the steps of: identifying the IP address from which a file is being downloaded; is sending a query to said first server to determine whether an IP address is on the Approved Web Site Database (claim 13); retrieving encryption key from said first server when the IP address is on the Approved Web Site Database (claim 24 lines 20-24); encrypting the downloaded file on its own or using the encryption key provided by said first server (claim 24 lines 20-24); requesting unique encryption code/key from said central server and/or generates own encryption key for the purpose of encrypting digital content being copied from a PC peripheral onto a memory of said personal computer (column 15 lines 37-58); and initializing a digital storage device to download and play/display encrypted files downloaded from said personal computer (column 14 lines 17-22); and a digital storage device with a PC interface, connectable to said personal computer, accommodates retrieval by said Software Program from information stored by said digital

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storage device, stores download files received through the user interface of the PC Software Program, retrieves encryption keys from said Software Program for downloaded files, plays and displays only files that are encrypted in conformity with said encryption code/key, and refuses to play and display files in an unencrypted format (column 18 lines 47-50)

***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kupka et al (6,434,535 B1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Fri 7:15 a.m to 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4832.

PWK



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